PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

Application No.	: 10/532,666
Confirmation No.	: 8703
Applicant	: Baret et al
Filed	: April 27, 2005
Title	: METHOD FOR PARAMETERING A FIELD DEVICE OF
	: AUTOMATION TECHNOLOGY
TC/A.U.	: 2184
Examiner	: Elias Mamo
Docket No.	: BARE3001/FJD
Customer No.	: 23364

REPLY BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22202-3514

Sir:

INTRODUCTORY COMMENTS

Pursuant to the provisions of 37 CFR 41.41, submitted herewith is Applicant/Appellant's Reply Brief on Appeal.

In the Examiner's Answer, issued on June 9, 2009, the examiner has made several comments which require consideration.

(1)

On page 6 of the Examiner's Answer, the examiner states:

> Packwood et al. Discloses a second field device in a fieldbus structure.
> McAlear discloses a method of remotely directing a computer activity from a controlling computer.... by using its on - site operating means such as

> keyboard, mouse and display unit...

And from this observation concludes on page 7 that:

> Therefore, the combined teachings of Packwood et al. And McAlear disclose the claimed feature; a first field device in the fieldbus structure is parameterized via the on-site operating means of the second field device.

It is respectfully submitted that the noted conclusion does not necessarily follow from the noted premise. How does a "method of remotely directing a computer activity from a controlling computer by using its on-site operating means..." translate into "a first field device in the fieldbus structure is parameterized via the on-site operating means of the second field device?" Where in the first quoted passage above is there a mention of a first and second field device? There is none, and if there is none, then what is the basis in the quoted passage for the conclusion that there is? The logic fails.

(2)

On page 7 of the Examiner's Answer, the examiner states:

> One cannot show nonobviousness by attacking references individually where the rejection is based on combinations of references.

If a rejection employs references A and B in a rejection, and the examiner mentions a particular disclosure in A and a particular disclosure in B, why is it not permissible for applicant to also mention the particular disclosures in the two references? That is not ignoring the combination. It is focusing on the combination by considering the disclosures relied upon by the examiner in each of the references. The ***In re Keller***, 208 USPQ 871 (CCPA, 1981) case cited by the examiner is not in point, because in that case applicant submitted an affidavit to attack only one of the references of the combination. That is not happening here.

The "attacking references individually" doctrine was advocated in the case law at a time when applicants were ignoring the suggestions for the combination found in one or both of the references. In other words, ignoring the suggestion(s) in favor of an individual attack on each reference. That is not what Applicant/Appellant is doing here. That is why Applicant/Appellant directed the examiner to the different problems addressed by both of the references. The examiner missed Applicant/Appellant's objective and considered Applicant/Appellant's discussion on this point as advocating the doctrine of nonanalogous art. The failure to have any problem coincidence does not necessarily translate to a nonanalogous art issue.

(3)

On page 9 of the Examiner's Answer, the examiner states:

> a person of ordinary skill in the art would consider the teaching of McAlear because

> It enables to access the operating and display software of a first field device.... from a second field device.....

Note the giant leap which the examiner takes from the teaching of McAlear. Again the logic fails, and one must conclude that the instruction provided us by the Supreme Court in the ***KSR*** case, cited in Applicant/Appellant's Brief in chief, that we must in the final analysis resort to plain "common sense" when applying 35 USC 103. It is respectfully submitted that this is not what is happening here.

Respectfully submitted,

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Date: September 9, 2009

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